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|--------------------|-------------|-----------------------|---------------------|
| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
| 08/656,811         | 06/03/96    | BARTSCH               | D 50865/JPW/J       |

08/656,811  
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18M1/0708

EXAMINER

KRIKORIAN, J

ART UNIT

PAPER NUMBER

18168

DATE MAILED:

07/08/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

**OFFICE ACTION SUMMARY** Responsive to communication(s) filed on 6/3/96 This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one (1) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-27 are subject to restriction or election requirement.

**Application Papers**

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

**- SEE OFFICE ACTION ON THE FOLLOWING PAGES -**

1 July 1997

***RESTRICTION REQUIREMENT***

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

**Group I.** Claims 1-6 and 15-22, drawn to a method to enhance long term memory and of treating a subject with long term memory defect, using a compound that interferes with binding of a cAMP-response-element-binding protein-2 to a protein or DNA, classified in Class/subclass 424/130.1+, for example.

**Group II.** Claims 7-14, drawn to a method of evaluating the ability of a compound to interfere with binding of a cAMP-response-element-binding protein-2 to a protein or DNA, classified in Class/subclass 435/7.1+, for example.

**Group III.** Claim 23, drawn to recombinant eukaryotic cell comprising DNA encoding cAMP-response-element-binding protein-2, classified in Class/subclass 435/240.2+.

**Group IV.** Claim 24, drawn to a transgenic, nonhuman mammal whose somatic and germ cells contain and express a DNA encoding a cAMP-response-element-binding protein-2, classified in Class/subclass 800/2+.

**Group V.** Claims 25-27, drawn to a pharmaceutical composition comprising an effective amount of a compound capable of interfering with binding of a cAMP-response-element-binding protein-2, classified in Class/subclass 424/130.1+, for example.

2. The inventions are distinct, each from the other because of the following reasons:

A. Inventions III-V are related as products. The products claimed are distinct because they are made by different methods, have different structures, and have distinct functional properties. For example, the cell of Group III is a different class of product from the mammal of Group IV and the compound of Group V. Thus, the inventions are deemed patentably distinct.

B. Inventions V and (I-II) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the pharmaceutical composition comprising a compound capable of interfering with a cAMP-response-

element-binding protein-2 (Group V) can be used in a materially different manner from that claimed, such as to identify the cAMP-response-element-binding protein-2 in an assay. The methods of Groups I-II do not use the products of Groups III and IV.

C. Inventions I-II are related as processes of use. The inventions are independent and distinct because they are materially different methods, involving different steps, reagents, issues, and objectives.

3. This application contains claims directed to the following patentably distinct species of the claimed invention.

A. If applicants elect Group I, then applicants are required to elect a compound species from within that Group.

Group I: Species A - antibody to cAMP-response-element-binding protein-2 (claims 2, 17)  
Species B - organic compound (claims 4, 19)  
Species C - peptide or peptide mimetic (claims 4, 19)  
Species D - small molecule (claims 4, 19)  
Species E - nucleic acid (claims 4, 19)

The species are distinct from each other because they are different classes of molecules with different structures, and are made by different methods. For example, a nucleic acid is made up of nucleotides whereas a peptide is made up of amino acids. A small molecule may be inorganic, and an organic compound may be a carbohydrate. Thus, it is apparent that the species are distinct. Applicants are required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 3, 5, 6, 15, 16, 18, and 20-22 are generic.

B. If applicants elect Group II, then applicants are required to elect a compound species from within that Group.

Group I: Species A - antibody to cAMP-response-element-binding protein-2 (claims 8, 12)  
Species B - organic compound (claims 10, 14)  
Species C - peptide or peptide mimetic (claims 10, 14)  
Species D - small molecule (claims 10, 14)  
Species E - nucleic acid (claims 10, 14)

The species are distinct from each other because they are different classes of molecules with different structures, and are made by different methods. For example, a nucleic acid is made up of nucleotides whereas a peptide is made up of amino acids. A small molecule may be inorganic, and an organic compound may be a carbohydrate. Thus, it is apparent that the species are distinct. Applicants are required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 7, 9, 11, and 13 are generic.

4. Applicants are advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

5. Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

9. Papers related to this application may be submitted to Group 1800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The appropriate Group 1800 facsimile telephone number for this art unit (1818) is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jacqueline Krikorian, Ph.D., whose telephone number is (703) 308-3964. While on a part-time schedule, Dr. Krikorian may normally be reached from 6:30 am to 3:00 pm on Mondays, and from 6:30 am to 12:30 pm Tuesdays and Thursdays. If attempts to reach the Examiner by telephone are unsuccessful, Supervisory Patent Examiner Paula Hutzell, Ph.D. may be reached at (703) 308-4310. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is (703) 308-0196.

JACQUELINE G. KRIKORIAN  
PATENT EXAMINER  
GROUP 1800

J.G. Krikorian, Ph.D.  
Patent Examiner